REMARKS

In the April 20, 2006 Office Action, the Examiner noted that claims 17-21, 23-27 and 30-33 were pending in the application; rejected claims 19-21 and 23-26 under the second paragraph of 35 U.S.C. § 112; rejected claims 17-21 and 30-33 under 35 USC § 102(b); and rejected claims 23-27 under 35 USC § 103(a). In rejecting the claims, U.S. Patents 4,553,206 to <u>Smutek et al.</u> (Reference A in the November 8, 2004 Office Action) and 5,717,912 to <u>Millett et al.</u> (Reference A in the April 20, 2006 Office Action) were cited. Claims 17-21, 23, 26, 30, 32 and 33 have been canceled and thus, 24, 25, 27 and 31 remain in the case. The rejections are traversed below.

Rejections under 35 U.S.C. § 112, Second Paragraph

In paragraphs 4-13 on pages 2-3 of the Office Action, claims 19-21 and 23-26 were rejected under the second paragraph of 35 USC § 112. Claims 19-21, 23 and 26 have been cancelled and claims 24 and 25 have been amended to remove the term "mapping object". Therefore, withdrawal of rejection under the second paragraph of 35 USC § 112 is respectfully requested.

Rejections under 35 U.S.C. § 102(b)

In paragraph 15 in pages 4-6 of the Office Action, claims 17-21 and 30-33 were rejected under 35 USC § 102(b) as anticipated by <u>Smutek et al.</u> Since claims 17-21, 30, 32 and 33 have been cancelled, this rejection is moot except for claim 31. Claim 31 has been amended to include limitations similar to those previously recited in claim 23 which depended from claim 31. Therefore, the rejection of claim 31 will be addressed below in place of the rejection of claim 23.

Rejections under 35 U.S.C. § 103(a)

In paragraph 17 on pages 6 and 7 of the Office Action, claims 23-27 were rejected under 35 USC § 103(a) as unpatentable over <u>Smutek et al.</u> in view of <u>Millett et al.</u> In rejecting claim 23, it was acknowledged that <u>Smutek et al.</u> **"does not disclose** ... processes ... used for one of determining indices and determining the new mapping object from the predefined digital image" (Office Action, page 6, lines 16-18, emphasis in original). Claim 31 has been amended to recite "determining an index from at least one parameter of a process, selected from a plurality of processes that at least one of transform and convert an original digital image differently" (claim 31, lines 3-4). It is submitted that <u>Smutek et al.</u> does not disclose this operation, because it only,

"generically **discloses** compression without giving any indication of plurality of processes for doing such" (Office Action, page 6, lines 18-19, emphasis in original).

In rejecting claim 23, it was asserted that column 11, lines 25-67 of <u>Millett et al.</u> discloses compression techniques "such as run length encoding, bit string fragment encoding, delta encoding and absolute element reference" (Office Action, page 6, lines 22-23). After listing these techniques, <u>Millett et al.</u> states that they are "four techniques to compress each **word** reference list" (column 11, line 32, emphasis added). In the detailed description that follows, it is clear that each technique is used with respect to at least one entire word. While there is a form of run length encoding that is used in compressing graphic images (commonly used in facsimile machines, that is not how the term is used in <u>Millett et al.</u> The run length encoding described in <u>Millett et al.</u> is a technique which "represents reference lists in terms of 'runs' of consecutive occurrences (e.g., if the word 'computer' occurs on pages 5-16, the list would be presented by the first occurrence, 5, and the number of consecutive occurrences thereafter, 11" (column 11, lines 55-59). The other three encoding techniques described in <u>Millett et al.</u> use a single bit to represent the occurrence or non-occurrence of a word (bit string fragment encoding), the distance between occurrences (delta encoding) and the number of the "granule" in which the word occurs (absolute element reference).

There is no suggestion in <u>Millett et al.</u> regarding how any of the encoding techniques could be applied to processing of "an original digital image" (claim 31, line 4). Therefore, it is submitted that the addition of <u>Millett et al.</u> to <u>Smutek et al.</u> does not overcome the deficiency of <u>Smutek et al.</u> acknowledged in the rejection of claim 23. For the above reasons, it is submitted that claim 31 patentably distinguishes over <u>Smutek et al.</u> in view of <u>Millett et al.</u>

Claims 24, 25 and 27 depend from claim 31 and therefore, it is submitted that claims 24, 25 and 27 patentably distinguish over <u>Smutek et al.</u> in view of <u>Millett et al.</u> for the reasons discussed above with respect to claim 31. Furthermore, it is submitted that claims 24 and 27 recite additional details not disclosed in <u>Smutek et al.</u>

In rejecting claim 24, it was asserted that column 9, lines 25-40 of <u>Smutek et al.</u> disclosed accessing a "stored image or a body of text ... if the at least one parameter corresponds, within a predefined tolerance, to at least one stored parameter of the ... stored image or ... body of text" (Office Action, page 7, lines 3-6). However, what is described at column 9, lines 25-40 is "the Index Header" (column 9, lines 26-27) which in the example has a "Common Length of Key Length segment ... [which] indicates that there are three characters common with the identify of the previous image stored in the file" (column 9, lines 28-31) and therefore, upon "reading the

fourth block segment of the Index Header a byte is found therein representing the letter G ... [which] is combined with the Common Key Length characters WAN read out of the previous file to recreate the proper Image Identify WANG" (column 9, lines 36-40).

It is submitted that there is nothing in column 9 of Smutek et al. which suggests any kind of "parameter [which] corresponds ... to at least one stored parameter" (claim 24, lines 2-3), because there is nothing that would constitute a "parameter" of any kind. Furthermore, there is no suggestion of any "predefined tolerance" (claim 24, line 3). In addition, there does not appear to be any sort of matching that occurs. All that is described in column 9 of Smutek et al. is how the title of an image is formed using letters that are in common with a previous file. Even if these letters or the title were somehow construed as a "parameter," claim 24 recites "the at least one parameter" which is a reference to the term "at least one parameter of a process" on line 3 of claim 31, where the "process" related to the "parameter" is used to "at least one of transform and convert an original digital image" (claim 31, line 4). There is no suggestion in Smutek et al. that the letters "WANG" either individually or together are used to either transform or convert an image. Therefore, it is submitted that claim 24 further patentably distinguishes over Smutek et al. in view of Millett et al.

In rejecting claim 27, it was asserted that column 5, lines 55-60 and Fig. 3 of Smutek et al. discloses that "the at least one parameter is a specific variable for influencing image data" (claim 27, lines 1-2). In the cited portion of column 5, it is stated that the "data ... [in] the index header of FIG. 3 ... indicates a variety of information about how an image is scanned, encoded, etcetera" (column 5, lines 57-60). The DATA portion of Fig. 3 includes portions labeled SOURCE OF DATA INPUT, SAMPLE DENSITY, STATE OF LAST DISPLAY, DEGRESS OF LIGHTNESS and ENCODING SCHEME. It is submitted that none of these even suggest "a specification **variable** for influencing image data" (claim 27, line 2, emphasis added). When the index header illustrated in Fig. 3 is already created. Thus, the image has been encoded and as a result, it would not be obvious that any "variable" would be stored in the index header. Therefore, it is submitted that claim 27 further patentably distinguishes over the combination of Smutek et al. in view of Millett et al.

Summary

It is submitted that the references cited by the Examiner do not teach or suggest the features of the present claimed invention. Thus, it is submitted that claims 24, 25, 27 and 31 are in a condition suitable for allowance. Reconsideration of the claims and an early Notice of Allowance are earnestly solicited.

Finally, if there are any formal matters remaining after this response, the Examiner is requested to telephone the undersigned to attend to these matters.

If there are any additional fees associated with filing of this Amendment, please charge the same to our Deposit Account No. 19-3935.

Respectfully submitted,

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